II. REMARKS/ARGUMENTS

1. The Office Action has been carefully considered. Reconsideration of this application, as amended, and in view of the following remarks, is respectfully requested.

A. References

2. The following U.S. patent were presented in the office action:

- US Patent 5,808,908, dated September 15, 1998, entitled "Method for measuring the usability of a system", ("Ghahramani")
- US Patent 5,999,908, dated December 7, 1999, entitled "Customer-based product design module", ("Abelow")
- US Patent 6,175,833, filed April 22, 1998, entitled "System and method for interactive live online voting with tallies for updating voting results", ("West")
- US Patent 6,556,974, filed December 30, 1998, entitled "Method for evaluating current business performance", ("D'Alessandro")
- US Patent 6,604,084, filed July 1, 1998, entitled "System and method for generating an evaluation in a performance evaluation system", ("Powers")

3. The following published U.S. patent application was the basis of claim rejections in the office action:

- US Patent Application 2002/0002482, filed July 1, 1997, entitled "Method and apparatus for performing surveys electronically over a network", ("Thomas")

B. Overview of Office Action

4. The office action:

- Required information under 37 CFR 1.105 regarding "The Survey System".
- Rejected claims 1-14 as being indefinite under 35 U.S.C. 112 second paragraph.
- Rejected claims 1-9 and 11-14 as being anticipated by Thomas under 35 U.S.C. 102(e).
- Rejected claim 10 as being rendered obvious by Thomas under 35 U.S.C. 103(a).

III. INFORMATION REQUIREMENT UNDER 37 CFR 1.105

5. The office action provided information regarding "The Survey System" offered by Creative Research Systems, and required information regarding the differences and any possible derivation or modification.

6. I, Kendyl A. Roman, was a promoter of the business concept, and technical consultant, on the survey system of the present invention, prior to the filing of the provisional patent application upon which the present application is based. I am the assignee of the entire interest in the patent application. I had personal knowledge of origins and development of applicant's survey system. The invention of the present application was an original and independent development of the inventor, Paul Raposo. It was not derived from, or related to, the Creative Research Systems' survey system, and therefore, was not a modification of said system.

7. The invention of the present application was a concept associated with confidential business plan for a survey system called "Research Runner™". Applicant's use of "the survey system" was a generic description for "Research Runner". Note that the term "Research Runner" appears in the Fig. 1 embodiment of the invention (see 100 "Research Runner Secure Server" and 110 "Research Runner Web Site").

8. Because of its independent development, there are many difference between Research Runner's survey system and Creative Research Systems "The Survey System". In the context of this application, applicant's novel concept of "Benchmarking Surveys" is a major difference between applicant's system and the system of Creative Research Systems.

9. I hereby declare, based on my personal knowledge and explicit inquiry with the inventor, Paul Raposo, that the survey system of the present invention was developed independently from, and not derived from, "The Survey System" of Creative Research Systems.

IV. CLAIM REJECTIONS UNDER 35 U.S.C. 112

10. The office action rejected claims 1-14 as being indefinite under 35 U.S.C. 112 second paragraph, stating that it is not clear what is meant by "benchmarking versions of a survey."

11. A major novel concept of the present invention is "benchmarking versions of a survey." Because this is a new concept, one of ordinary skill in the art would not have known what this meant without reference to the specification that introduces this new concept and defines what it means. In attempting to describe this novel concept, the applicant acting as his own lexicographer, applied an old term "benchmark" in combination "versions of surveys" to define this new feature.

12. Paragraphs 0002 through 0012 and 0036 (as identified in of the published application 2001/0049621) help define meaning of the new term by discussing what it is, what it is like, and how it works, and the best mode of the invention.

13. At the time of filing, the applicant believed that the simple claim language of claim 1, "A survey system whereby versions of a survey is benchmarked" would bring in detailed definitions of the specification and would be sufficient to claim the new novel feature. However, in the years since filing, the Federal Circuit has focused the courts on "the plain ordinary meaning" of the claim language. Therefore it is now prudent to more distinctly point out the meaning of the terms and to incorporate the details in amended claim language.

A. Terminology

14. There are many meanings of the term "benchmark" in computer science. For example, each of the references cited in the office action that use the word "benchmark" does so with a different meaning:

- Ghahramani uses the word "benchmark" to discuss a way of comparing "processing power", namely "measuring the time to complete various tasks using different software products (e.g., word processing, graphics, spreadsheets, databases) that emphasize different processing functions (e.g., floating point operations, integer operations, etc.)." This is a valid meaning in computer science but is not the new meaning used by applicant.
- Abelow uses the term "benchmarking probes" as a way to "assess the ongoing value of the product to the Customer, the Customer's opinions of competing products, and that Customer's specific needs for products in this category in the future." This is yet another valid, yet distinct, meaning in computer science but is not the new meaning used by applicant.
- D'Alessandro uses the term "benchmark" in relation to survey data, "Accurate survey data, based on behavioral follow-up questions, can be used to *compare or benchmark organizations* within and among industries" (emphasis added). The use of the term is in relation to using the data to "benchmark organizations". This is yet another valid, yet distinct, meaning in computer science but is not the new meaning used by applicant, which in contrast is benchmarking versions of surveys, not benchmarking organizations.

  Note: Thomas, West, and Powers do not use the term benchmark.

15. The Applicant is explaining the invention's novel concept for a survey system by using the word benchmark in an analogous way that it has been used before. Namely,

computer processor power "benchmarks" allow two different processors (e.g. a Intel Pentium 3 v. a PowerPC 603) to be compared even though other quantifiable measures are not comparable. For example, a 100 MHz Pentium 3 is not as powerful as a 100 MHz PowerPC. Because different processors are being measured, the MHz number can't tell you which one is more powerful. It is like comparing apples and oranges. The number of pieces of fruit does not tell you how much Vitamin C you are getting. Is there more Vitamin C is 3 apples than there is in 2 oranges? Because different fruits are being measured, quantity does not tell you which group will give you more Vitamin C.

> "[0003] Surveys or polls are commonly used to collect information. Over time a survey may be modified. Also once a survey is complete another different survey may be used to collect follow-up information. *It is difficult to compare different surveys*. It would be valuable to be able to simply see the results of a survey as a number or an index that would have meaning over time." (emphasis added)
>
> "[0004] In accordance with the present invention a method of creating benchmarks for surveys which can be used to graphically display over time and over multiple different surveys an overall trend." (emphasis added)
>
> "[0012] Surveys are all different, even different versions of the same survey. These differences can be due to questions added, questions removed or questions modified. Question modifications can include changing wording, changing options or changing types (changing a close ended question to an open ended question and vice versa)." (emphasis added)
>
> "[0013] Benchmarks provide a quantifiable way to conceptually grade and measure the success of a survey against goals. These benchmarks transcend surveys and differences within these surveys including question changes and wording. The benchmark is an index that works in much the same way that a stock market index works (by selecting key stocks, weighting them and monitoring their activity as an indication of the overall stock market activity)." (emphasis added)

> "[0015] As part of the survey design, clients can define benchmarks. Goals and weights are used to evaluate an index that quantifies the "success" of the survey. The index works in much the same way that a stock market index works (by selecting key stocks, weighting them and monitoring their activity as an indication of the overall stock market activity). Target values can be assigned to any number of questions on the survey. Weights are then applied to these questions indicating the impact any one question has on the overall survey index, relative to other questions on the survey. An index is then calculated for every survey ..." (emphasis added)
>
> "[0016] The index is a percentage that indicates the proximity of the survey answers to the desired goals with 100% indicating that the completed survey likely meets the desired goals. The index can then be used to compare or rank surveys." (emphasis added)

16. Surveys have the same problem. When surveys change, from version to version, the tallied up results cannot be compared. Applicant's specification explains this problem with not being able to compare the results of different survey's and discloses a novel way of solving this problem.

17. From the specification it can be understood that a "benchmark" in the context of the present application is an index defined by assigning target values to individual survey questions, applying weights to the answers, and using the weighted values to calculate an overall survey index that can be used to compare or rank different surveys and different versions of the same survey which versions are comprised of modified questions.

18. In the context of the present application, when "versions of a survey are benchmarked" when a group of different surveys each receive an index that has been calculated using target values and weights such that results of the different surveys can be compared even though the results of the surveys measure different things.

19. In the context of the present application, "goals" are overall quantifiable measures which are 100% when met, "target values" are a number associated with the answer to an individual question which indicates that the goal is met, and "weights" are conversion factors which when applied to an individual answer value contributes to the overall survey index. Goals persist over time. The index for each survey is a measure against the goal. The indexes for different surveys can now be compared where previously the raw results of questions or surveys could not be compared.

B. Applicant's Definitions may Overcome 35 U.S.C. 112

20. The application of applicant's definition from the specification for the claim terms should be sufficient to overcome some of the 112 rejections. However, as stated above, it is now prudent to provide even more distinct claim language.

C. Claim Amendments Overcome 35 U.S.C. 112

21. The claims have been amended as required more particularly point out and distinctly claim the novel subject matter of the applicant's invention. These amendments were not made to overcome prior art. These amendments add no new matter, but only add details from the specification.

V. CLAIM REJECTIONS UNDER 35 U.S.C. 102(E)

22. The office action rejected claims 1-9 and 11-14 as being anticipated by Thomas under 35 U.S.C. 102(e).

23. The claims have been amended with details that more particularly point out and distinctly claim the novel subject matter of the applicant's invention. These amendments make the basis for the 102(e) rejections mute.

24. Further, even if the claims had not been amended, Thomas did not teach or suggest the novel elements of applicants invention. For example, Thomas did not teach or suggest a "survey system whereby versions of a survey is benchmarked" as required by original claim 1. Nowhere does Thomas even use the word benchmark. At ¶37 and ¶77 (cited by the Office Action), Thomas only teaches conventional archiving of survey data. This is not the same or equivalent to being benchmarked. Merely archiving data does not solve the problem that is solved by applicant's novel benchmarking. Similarly claim 8 required "creating a benchmark". Thomas does not teach or suggest creating a benchmark. For this reason alone, both independent claims and their dependent claims would have been patentable over Thomas..

25. Further, with respect to claim 2, Thomas did not teach two servers, namely a "secure server" and a "server web site" as required by claim. Instead at ¶35 Thomas teaches client computers not servers at all. At ¶65, Thomas teaches a single, not two, Internet server 308. Thomas fails to teach a second "secure". Thomas lacks the required server elements of claim 2.

26. Further, with respect to claim 8, Thomas failed to teach or suggest the goals, and weights required to benchmark as survey as required by applicant's invention.

27. Further, with respect to claim 11, Thomas failed to teach or suggest that "individuals ... have entered into an agreement to respond to surveys." Instead Thomas taught that potential participants register. This is not the same or equivalent to entering into a contract that they will respond to surveys.

28. Further, with respect to claim 13, Thomas failed to teach or suggest that "individuals are panelists, having been selected based on particular characteristics". Thomas

does not clearly teach the distinction between registered participants and individuals specifically selected to be on panels.

29. Further, with respect to claim 14, Thomas failed to teach or suggest that "panelists are compensated for their participation". Instead Thomas taught that participants are given incentives to register. This is not the same or equivalent to receiving compensation for participating in each survey under the contract agreements of claim 11, after being selected to be a "panelist" in claim 13.

VI. CLAIM REJECTIONS UNDER 35 U.S.C. 103(A)

30. The office action rejected claim 10 as being rendered obvious by Thomas under 35 U.S.C. 103(a).

A. Claims 10 Not Rendered Obvious by Thomas

31. Claim 10 is dependent of claim 8 and for all the reasons above is patentable over Thomas. In particular because Thomas fails to teach the required element of a benchmark, as defined in the context of the present application's specification (see above), it cannot suggest "generating a graph based on said benchmark" as required by claim 10.

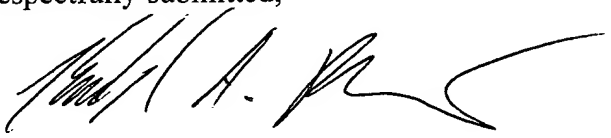
32. While generating graphs of survey results was known, it would have been impossible for generating a graph of a "benchmark", as defined in the context of the present application's specification, which is a novel concept which was not known in any of the cited prior art.

VII. RECONSIDERATION REQUESTED

33. The undersigned respectfully submits that, in view of the foregoing amendments and remarks, the rejections of the claims raised in the Office Action sent October

10, 2004 have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that these claims be allowed, and that this case be passed to issue. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to call the undersigned inventor at 408-739-9517.

Respectfully submitted,



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Date: April 8, 2005